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GREENBERG TRAURIG, LLP 1900 UNIVERSITY AVENUE FIFTH FLOOR EAST PALO ALTO, CA 94303			EXAMINER ALBERTALLI, BRIAN LOUIS	
			ART UNIT	PAPER NUMBER
			2655	

DATE MAILED: 02/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/000,111

Applicant(s)

ROECK, JUERGEN

Examiner

Brian L. Albertalli

Art Unit

2655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-11, 13-18, 20 and 21 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-4, 6-11, 13-18, 20 and 21 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The amendments to the claims have been entered. Claims 1-4, 6-11, 13-18, 20 and 21 are currently amended and claims 5, 12, and 19 are cancelled.

Response to Arguments

2. Applicant's arguments filed December 7, 2005 have been fully considered but they are not persuasive.

3. Regarding Applicant's arguments with respect to the rejections of claims 7, 14, and 21 under 35 U.S.C. 112, 1st paragraph, the Examiner maintains that there is an insufficient written description to support the claims. Initially, the Examiner notes that claim 15 still requires that "information blocks" are parsed by a natural language rule and limitation set (and not by a template, as argued), and that the "information elements" include email, HTML, graphics images, or audio. Since there is no mention of a template in claim 15, the Applicant's arguments that information blocks, such as graphics may be parsed and modified according to a template, are considered moot with respect to claim 21.


Additionally, even with the addition of the "templates" in independent claims 1 and 8, there is still insufficient written description to support this limitation in the claims. The Applicant has asserted that information blocks such as graphics may be parsed according to a template. Firstly, how an "information element" is "parsed" by a "template" is not described in the specification with any detail (the specification only

reiterates "in one embodiment additional templates... may be used as well"). It is still not clear what action would need to be taken to "parse" an "information element" according to a "template", and one of ordinary skill in the art would not be able to implement the claimed invention without undue experimentation. Secondly, independent claims 1 and 8 require the parsing is done by a template and/or natural language rule and limitation set. Therefore, each information element that does not contain textual elements (such as audio, video, or graphics images) is parsed by the same template. How one could parse audio, video and graphics images with one single template is unclear, and it is doubtful that such an action could even be performed.

Therefore, the rejections of claims 7, 14, and 21 under 35 U.S.C. 112 1st paragraph are maintained.

4. Regarding Applicant's arguments with respect to the rejections of claims 1, 8, and 15 under 35 U.S.C. 112, 2nd paragraph, the Examiner maintains that the term "transitional zones" is vague and indefinite.

The Applicant has pointed to the description of transitional zones in the specification, wherein the specification defines a "transitional zone" as the "beginning" and "ending" of an "information block". While the "information blocks" illustrated in Fig. 1 have some type of "transitional zones" illustrated (zones a, b, c, and d), this does not define what a transitional zone actually is. The Applicant further provides the example given in the specification for textual information blocks, but this does not provide any insight as to what the transitional zone of an information element may be if the



information element were anything other than text (i.e. graphics, video, audio, etc.) For example, in Fig. 1, the transitional zones b and c are illustrated as the left and right margins of the information block 139. If the information block 139 were a graphic image, does this mean that a transitional zone is the left and right margins of the picture? Or, could the term transitional zone include margins on the top and bottom of the picture? Clearly, the “beginning” and “ending” of a graphic image is not sufficient to define where a transitional zone exists within a graphic image.

Furthermore, even assuming that the “beginning” and “ending” give enough of a definition of “transitional zone” to identify where the transitional zones occur for each of the types of media described, the term transitional zone is still vague and indefinite because there is no indication as to how large a transitional zone in a given information element could be. For example, if the information element were a 2-hour long video, would the “beginning” of the video (and thus the transitional zone) be defined as the first hour of the movie, the first 10 minutes, or the first 10 frames of video information? That is, there is no description as to any type of objective, measurable range that would define the transitional zone of an information element.

Therefore, for the purposes of examination any modification of any part of an “element” has been interpreted herein as equivalent to “modifying transitional zones” and the rejections of claims 1, 8, and 15 under 35 U.S.C. 112, 2nd paragraph are maintained.

5. Regarding the rejection of claims 1, 8, and 15 under 35 U.S.C. 102(b), given that the Applicant has provided no objective, measurable range to describe a “transitional zone”, therefore, the Examiner’s interpretation of transitional zone is valid.

Furthermore, Holloran et al. disclose a set of information elements is provided (the phrases in the table in column 4), and that these information elements are “fused” into a cohesive communication (the elements are concatenated into a single sentence, column 5, lines 42-45), wherein “transitional zones” are modified to provide a cohesive communication (for example, “The” is added to the beginning of “Editor” to make the comprehensive sentence, column 5, lines 34-40).

Therefore, the rejections of claims 1, 8, and 15 under 35 U.S.C. 102(b) are maintained.

6. Regarding the rejection of claims 3, 10, and 17, the Applicant’s arguments are not persuasive, because Holloran et al. disclose the list of required elements (step data table 102) includes links to information blocks (such as the illustrated link to verb table 112).

Furthermore, since the Applicant has removed the requirement that the communication be “a responder or email”, the rejection of claims 3 and 10 under 35 U.S.C. 103(a) is withdrawn and claims 3 and 10 are now rejected under 35 U.S.C. 102(b) in view of Holloran et al.

7. Furthermore, with regard to the use of official notice in the rejections of claim 15, it is noted that the applicant has not made any attempt to traverse the assertion of official notice (i.e. that mailers and responders are well known), therefore the well-known in the art statement is taken to be admitted prior art (see MPEP 2144.03).

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-4, 6-11, 13, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Holloran et al. (U.S. Patent 5,369,573).

In regard to claims 1 and 8, Holloran et al. disclose a method and machine readable medium comprising:

receiving a list of required elements (Fig. 1, the user enters data into a step data table 102, which contains all of the elements required to generate the desired communication, column 4, lines 18-26 and column 5, lines 34-39);

adding elements from the list to a communication until an end of the list is reached, and each element in the list of required elements has been added to the communication (all of the data in step data table 102 is concatenated to generate a communication, column 4, lines 42-51; further, in the example given, each element in

the table in column 4 is added to the communication, with Requirement being modified to “shall”, column 6, lines 19-25);

parsing and modifying the elements according to a template and/or natural language rule and limitation set, wherein parsing and modifying includes modifying transitional zones and fusing the elements into a cohesive composite communication (concatenation rules are used in combining the elements, the concatenation rules being natural language rules and limitations such as what form of the verb is allowed, punctuation, etc., column 6, lines 19-36; furthermore, the elements are modified to ensure they meet the set of rules defined by the syntax, column 5, lines 43-45 and column 6, lines 37-43); and

dispatching the communication to media channels (the steps are then added to documents, which are sent to an output device, column 7, lines 19-28; any output of a communication is equivalent to “dispatching” to “media channels”).

In regard to claims 2 and 9, Holloran et al. disclose parsing and modifying includes using input from the list of required elements (elements from data table 102 are parsed and modified to ensure they meet the rules defined by the syntax, column 5, lines 46-51).

In regard to claims 3 and 10, Holloran et al. disclose the list of required elements includes information blocks (such as objects 126, column 3, lines 27-30) and links to

information blocks that are embedded into the communication (such as the illustrated link to verb table 112, column 3, lines 23-26).

In regard to claims 4 and 11, Holloran et al. disclose the list of required elements includes information blocks (such as objects 126, column 3, lines 27-30) and/or links to information blocks (such as the illustrated link to verb table 112, column 3, lines 23-26) including an action item result in the list (the elements define a step in a procedure that one is to follow, column 4, lines 18-26).

In regard to claims 6 and 13, Holloran et al. disclose the information blocks are retrieved from at least one database or repository (the elements are retrieved from data table 102, a data table is equivalent to a "database or a repository", column 5, lines 46-51).

In regard to claims 7 and 14, Holloran et al. disclose the elements include information blocks which include text (as defined by the specification, an "information block" is any type of "multimedia information type", the elements in data table 102 are text, and thus, "information blocks", see Fig. 1).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15-18, 20, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holloran et al.

In regard to claim 15, Holloran et al. disclose an apparatus comprising:

a composer to receive a list of required elements and add elements from the list to a communication until an end of the list is reached, and each element in the list of required elements has been added to the communication (Fig. 1, the user enters data into a step data table 102, which contains all of the elements required to generate the desired communication, column 4, lines 18-26 and column 5, lines 34-39; all of the data in step data table 102 is concatenated to generate a communication, column 4, lines 42-51);

a natural language processor coupled with the composer, the natural language processor to parse and modify the elements according to a natural language rule and limitation set, and thereby to modify transitional zones and fuse the elements into a cohesive composite communication (concatenation rules are used in combining the elements, the concatenation rules being natural language rules and limitations such as what form of the verb is allowed, punctuation, etc., column 6, lines 19-36; furthermore, the elements are modified to ensure they meet the set of rules defined by the syntax, column 5, lines 43-45 and column 6, lines 37-43; further, in the example given, each element in the table in column 4 is added to the communication, with Requirement being modified to "shall", column 6, lines 19-25); and

an output device coupled with the natural language processor, the output device to dispatch the communication to media channels (the steps are then added to documents, which are sent to an output device, column 7, lines 19-28; any output of a communication is equivalent to “dispatching” to “media channels”).

Holloran et al. do not disclose that the dispatch of the communication is performed through a “mailer or responder” (which has been interpreted herein as email or the like).

The Applicant’s admitted prior art discloses it is notoriously well known in the art to “dispatch communications” with a “mailer or responder”, so that the communication can be reviewed by another person, or the communication can be distributed to the audience for which it was intended. Especially in the case of email, this provides a fast, generally free, and efficient (in that a physical copy of the communication does not have to be created) means for dispatching communications. Further, with regard to claims 3, 10, and 17, “embedding” content from the list into a responder or mailer has been interpreted herein as including content that was in the list in a message that will be sent by the mailer.

It would have been obvious to one of ordinary skill in the art at the time of invention to modify Holloran et al. to dispatch the completed communications over to media channels through a mailer or responder, so that the communication can be reviewed by another person, or the communication can be distributed to the audience for which it was intended.

In regard to claim 16, Holloran et al. disclose parsing and modifying includes using input from the list of required elements (elements from data table 102 are parsed and modified to ensure they meet the rules defined by the syntax, column 5, lines 46-51).

In regard to claim 17, Holloran et al. disclose the list of required elements includes information blocks (such as objects 126, column 3, lines 27-30) and links to information blocks that are embedded into the communication (such as the illustrated link to verb table 112, column 3, lines 23-26).

In regard to claim 18, Holloran et al. disclose the list of required elements includes information blocks (such as objects 126, column 3, lines 27-30) and/or links to information blocks (such as the illustrated link to verb table 112, column 3, lines 23-26) including an action item result in the list (the elements define a step in a procedure that one is to follow, column 4, lines 18-26).

In regard to claim 20, Holloran et al. disclose the information blocks are retrieved from at least one database or repository (the elements are retrieved from data table 102, a data table is equivalent to a "database or a repository", column 5, lines 46-51).

In regard to claims 21, Holloran et al. disclose the elements include information blocks which include text (as defined by the specification, an "information block" is any

type of "multimedia information type", the elements in data table 102 are text, and thus, "information blocks", see Fig. 1).

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian L. Albertalli whose telephone number is (571) 272-7616. The examiner can normally be reached on Mon - Fri, 8:00 AM - 5:30 PM, every second Fri off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Hudspeth can be reached on (571) 272-7843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BLA 2/8/06


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